

**REMARKS/ARGUMENTS**

Claims 1-17 and 19-26 are pending in this application, claim 18 having been canceled.

Drawing, Specification Objections.

New proposed Figures 5 and 6 are submitted herewith for the Examiner's approval, along with a corresponding new paragraph in the specification. These are submitted to address the Examiner's objection to lack of support in the drawings and/or specification for certain terms in the claims. This does not add new matter, since all of these elements were described in the originally filed claims, and any other aspects of the drawings would be obvious to one of skill in the art from the terms in the claims.

Also, the specification has been amended as a result of being reminded that FSR® and Force Sensing Resistor® are trademarks of Interlink Electronics. The claims have also been amended to use the term "pressure" instead of "force" to avoid a trademark being used in the claims.

Section 112 Rejection, Claim 24.

Claim 24 has been amended to add a reference to "wheel," and thus is believed to overcome the section 112 rejection.

New IDS.

A new IDS has been submitted herewith. One of the items is a picture of an IBM mouse having a mini-stick, manufactured by the assignee of the present application on behalf of IBM. The mini-stick is mounted over a FSR® resistor of Interlink. In operation, the top of the stick moves perceptibly in response to a user's finger pressure. The claims as amended are believed to distinguish this, since they require a material over the pressure-sensing resistor which transfers force without noticeable movement of the material. Claim 2 further distinguishes this IBM mouse by calling for a button, as opposed to a stick.

Claim 23.

Claim 23 was indicated as allowable if rewritten in independent form. Claim 23 has been so rewritten, and accordingly is believed to be in condition for allowance.

Section 102 Rejection, Claims 1, 2 4-9.

These claims have been rejected as anticipated by Armstrong, which was cited in the Background of the application. Claim 1 has been amended to further clarify the distinction from Armstrong, by indicating that the material does not visibly move when a user applies force. Claim 1 already states that there is no visible deformation. Armstrong, on the other hand, teaches an elastomeric dome cap (107, 108) which depresses. The office action refers to sensor 10 as being a force sensing resistor. However, as shown in Fig. 7, sensor 10 includes a depressable cap 12, which must be visibly depressed to have element 14 contact elements 16 and 18 to provide a connection. Similar for the buttons of Figs. 11, 12, 14 and 15, an element 12 or 44 must be visibly depressed by the user. The present invention, on the other hand, uniquely provides an interface with the user which simply transfers pressure, and does not itself need to be depressed. In a button form, as set forth in claim 2, this is low-profile and doesn't require a user to lift his finger as for a mini-stick, or require a construction to recess a mini-stick.

Section 103 Rejection, Claims 3, 7-9, 10.

These claims are dependent on claim 1 and are believed allowable for the same reasons set forth above, and at least the additional reason of the combinations recited in the Office Action not being obvious.

Section 103 rejection of Claims 11-17 over Armstrong and Gillick.

Claim 11 distinguishes between the amount of time a user activates the input element. For example, a short amount of time could be a single scroll motion, while a longer amount of time could be a continuous scroll motion. Neither Armstrong nor Gillick nor the combination show or suggest this. Armstrong only suggests that the long amount of time be the "analog" function, with the scrolling speed varying with pressure, not amount of time. The amount of time in Armstrong determines a switch between two different functions - forward/back and scrolling, not different modes of scrolling. Gillick shows holding down the

roller and turning it while it is held down as a way to do PowerScroll. Neither mentions the amount of time as the distinction between two modes of scrolling, and thus it would not be obvious to combine them to yield the present invention.

Section 103 Rejection of Claims 18-20 over Armstrong and Yaniger.

Claim 18 has been canceled. Claim 19 has been amended to incorporate the language of claim 1, and has been amended, similarly to claim 1, to indicate that the overlay (button) pressed by the user transmits the force without visible deformation or movement of the overlay. As noted above, Armstrong has a dome cap which deforms in response to a user pressing it. Accordingly, the combination of Armstrong and Yaniger does not show or suggest claim 19 as amended. Claim 20 is dependent on claim 19 and is believed allowable for the same reasons as claim 19.

Claims 21-26.

Claims 21-24 were not rejected on any art. Claim 24 was rejected under Section 112, and this has been corrected as noted above. Claims 25 and 26 were rejected over the combination of Armstrong and Gillick. It was not clear if claim 21 was intended to be rejected, since claims 25 and 26 depend from it, and would be allowable if claim 21 was allowable. Turning to claim 21, it sets forth a scrolling element with a switch button proximate the scrolling element for activating continuous scrolling. Armstrong teaches using the same button, with different amounts of force for continuous scrolling. Gillick uses the roller itself, when depressed, to activate its PowerScroll function. The present invention comes up with a third way, believed to be more intuitive to a user, of a separate button near the scrolling element. It would not be obvious to combine Armstrong and Gillick to provide this functionality (continuous scrolling) since each already provides it, in different manners. There is no suggestion in either to modify them to provide continuous scrolling in the manner of claim 21. Accordingly, claim 21 is believed allowable, along with claims 22-26 which depend on it.



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Reply to Office Action of September 12, 2003

PATENT

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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Attachments

- Proposed new Figs. 5, 6 (1 sheet)
- IDS w/ PTO/SB/08A,B and 22 cited refs

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